

R E M A R K S

Claims **1 - 50 and 52** are pending.

Claims **1, 16, 19, 31, 34, 46, 49, 50 and 52** are independent.

Applicants' Previous Response Not Considered

In response to the Office Action mailed November 17, 2000 (the "First Office Action"), Applicants filed a Response on April 17, 2001 (the "First Response"). It appears that the First response was not considered by the Examiner.

For example:

- the summary of the present Office Action states that the present Office Action is responsive to communications filed 12/28/98, instead of the date of the First Response (April 17, 2001).
- the present Office Action lacks any type of acknowledgement of or response to Applicants' arguments in the First Response.
- the present rejections appear to be copies of the rejections of the First Office Action
- page 21 of the present Office Action sets forth a rejection of claim **51**, which was canceled in the First Response
- the present Office Action does not set forth a rejection of claim **52**, which was added in the First Response

Objection to Title

The present title is descriptive of the claimed inventions. The claimed embodiments are all directed to vending products, and there is no requirement that the title track any feature that is present in all pending claims. Further, there is no basis for rejecting a title which is "too generic".

Applicants note that independent claim **52** does not include the phrase "product identity concealment", which the Examiner believed to be present in all independent claims.

Claim Amendment

Claim **52** has been amended to correct a minor and obvious typographical error. No amendment was made for a reason related to patentability.

Improper Official Notice

Applicants had previously requested references to support the assertions made in the form of Official Notice and what would motivate a person of ordinary skill in the art to combine or modify references in the manner proposed by the Examiner.

Applicants again request references to support the assertions made in the form of Official Notice and what would motivate a person of ordinary skill in the art to combine or modify references in the manner proposed by the Examiner. MPEP 2144.03.

Proper Use of Official Notice

Finally, officially-noted subject matter cannot be used as the basis for a rejection under 103. In other words, official notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art.

See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added);

In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**") (emphasis added);

In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

Official Notice may be used, if at all, to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching.**") (emphasis added).

Section 103(a) Rejections

Claims **1 - 51** are rejected as being unpatentable U.S. Patent No. 5,997,236 to Picioccio in combination with Koga and / or various Official Notice by the Examiner. Applicants respectfully traverse the Examiner's Section 103(a) rejection.

Applicants arguments from the First Response are reiterated. In addition, several portions thereof are emphasized here.

A. Independent Claim 1

The Examiner acknowledges that the following limitations of claim **1** are not disclosed by Picioccio:

maintaining a database of product data, including normal price data and minimum acceptable price data for each of a plurality of products;
selecting a product from among the plurality of products based on the monetary value and the minimum acceptable price data;

As stated in the First Response, even if the combination of Picioccio and the Official Notice were proper, not all limitations are suggested.

Regarding the "maintaining" step above, in Picioccio there is *no possibility of operating at a loss or not meeting the breakeven point*. In Picioccio, the consumer receives the same quantity of product at the same price that would have been paid had the mystery option not been

selected. Accordingly, there is no need to consider minimum acceptable price data, and thus nothing in Picioccio suggests the modification proposed by the Examiner.

Regarding the "selecting" step above, there is no need to consider minimum acceptable price data, much less selecting a product based on minimum acceptable price data. Thus, nothing in Picioccio or any other reference suggests the modification proposed by the Examiner.

B. Independent Claims 19, 34 and 49

Independent claims **19, 34 and 49** are apparatus and article of manufacture claims corresponding to independent claim 1. Accordingly, independent claims **19, 34 and 49** are likewise patentable over the references cited by the Examiner.

C. Independent Claim 16

The arguments above regarding the nonobviousness of claim 1 are applicable to the nonobviousness of independent claim 16.

D. Independent Claims 31, 46 and 50

Independent claims **31, 46 and 50** are apparatus and article of manufacture claims corresponding to independent claim 16. Accordingly, independent claims **31, 46 and 50** are likewise patentable over the references cited by the Examiner.

E. Independent Claim 51

Claim **51** had been canceled in the First Response, rendering the rejection moot.

F. Remaining (Dependent) Claims

Since all pending independent claims are nonobvious, the remaining dependent claims are likewise nonobvious.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

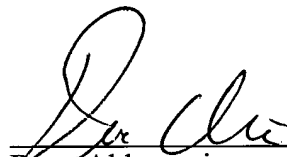
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$920.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Dean Alderucci

Attorney for Applicants
Registration No. 40,484
Alderucci@WalkerDigital.com
Walker Digital Corporation
Five High Ridge Park
Stamford, CT 06905-1326
203-461-7337 / voice
203-461-7300 / fax

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Date

**CLAIM AMENDMENTS
MARKED UP FORM**

Please **AMEND** the claims as follows

52. (AMENDED) A method for selling from a vending machine, the method comprising:
- receiving currency that represents a first monetary amount;
 - receiving a selection of a first product;
 - determining a price of the first product;
 - determining a demand of the first product;
 - calculating a second monetary amount based on the difference between the first monetary value and the price of the first product[.];
 - selecting a second product from the plurality of products based on the second monetary value and minimum acceptable price data for the plurality of products;
 - outputting an offer of the selected second product without disclosing the identity of the selected second product;
 - receiving an acceptance of the offer; and
 - dispensing the selected second product.